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19 MAR 2007

In re Application of

Evans

Application No.: 10/561,686

PCT No.: PCT/GB03/05267

Int. Filing Date: 02 December 2003

Priority Date: 28 June 2003

Attorney Docket No.: GB920030049US1

For: Predictive Graphical User Interface
With Speculative Execution

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DECISION
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ON
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PETITION
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This is in response to the renewed petition under 37 CFR 1.47(b) filed on 26 February 2007.

DISCUSSION

In a Decision mailed on 28 September 2006, the petition under 37 CFR 1.47(b) filed on 10 July 2006 was dismissed without prejudice because

Regarding requirement (2), Counsel has presented a copy of a letter from Evelyn Steer to Mr. Evans, dated "4 November 2003," which references an enclosed "final version of the patent application, and the formal papers. There are two forms to be signed and dated. The first is called 'Declaration and Power of Attorney'..." Petitioner indicates that "no response was received." However, petitioner has not provided a statement by a person having first-hand knowledge attesting that the letter and attachments were in fact mailed to Mr. Evans. As such, it would not be appropriate at this time to construe Mr. Evans' failure to return the executed declaration as a "refusal" within the meaning of 37 CFR 1.47(b).

Concerning requirement (4), the instant renewed petition is accompanied by a declaration naming "David E. Evans" as the sole inventor. This declaration has not been executed on behalf of Mr. Evans, and therefore it is not acceptable for purposes of compliance with requirement (4).

Regarding requirement (5), Petitioner has not specifically identified the 37 CFR 1.47(b) applicant nor presented proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, in the manner described supra. In the absence of such a showing, it would be inappropriate to conclude that requirement (5) has been satisfied.

Regarding requirement (6), the petition does not appear to include a showing that according the application status under 37 CFR 1.47(b) is necessary to preserve the rights of the parties or to prevent irreparable damage.

Regarding **requirement (2)**, the instant renewed petition is accompanied by a "Declaration By Evelyn Steer..." which describes her attempts obtain Mr. Evans' signature. She states that she sent a letter and a "copy of the application, declaration and assignment" to Mr.

Evans on 04 November 2003, that she sent him an email on 22 December 2005, that she mailed "correspondence" to him on 16 January 2006, and that she sent "via a courier a copy of the application, declaration and assignment to the last known address of Mr. Evans" on 08 January 2007. However, the "Declaration By Evelyn Steer..." is not accompanied by copies of any of this correspondence. It is noted that Ms. Steer references an "Exhibit 'A'," but the only "Exhibit 'A'" which accompanied the instant renewed petition (and is present in the application file) is a copy of a declaration document signed by Mark Cox. Ms. Steer also refers to "an attempt... to contact him through an old colleague," but no statement detailing this "attempt" on the basis of first-hand knowledge has been provided (for instance, who was the colleague, was said colleague connected to Mr. Evans in a capacity likely to result in continued contact, who contacted said colleague, etc.). Also, regarding the correspondence of 08 January 2007, Ms. Steer states that "the confirmation papers accompanying the papers were signed by someone other than Mr. Evans," but has not provided a copy of such "papers." As such, petitioner has not adequately established that Mr. Evans refused to execute the application after having been presented with a complete copy of the application papers (and an oath or declaration), or that he could not be found or reached after diligent effort within the meaning of 37 CFR 1.47(b).

With respect to **requirement (4)**, petitioner has presented a declaration signed on behalf of David Edward Davis by "Mark Cox, Manager." However, petitioner has not established the authority of Mr. Cox to sign, as the position of "Manager" does not ordinarily give rise to the authority to sign on behalf of an organization. See MPEP 324.

Concerning **requirement (5)**, petitioner has provided a copy of a "Confidential Information, Copyright and Invention Agreement" signed by David Evans and by D. Fowler in the capacity of "IBM Personnel/Recruitment Officer." MPEP 409.03(f)(C) states in part that

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

The instant Agreement provides in pertinent part that

If in the course of my employment by IBM, either alone or with others, I make any invention, IBM will own such invention and all patent rights in it in accordance with law and I shall promptly disclose such invention to IBM. Any such invention which by law does not belong to IBM will belong to me.

Review of the application file reveals that petitioner has not provided the required "statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant" as described at MPEP 409.03(f)(C). Under the language appearing in the Agreement, it appears that a showing that the invention was made in the "course of" Mr. Evans' employment would be appropriate, but such has not been provided. Therefore, requirement 5 has not been satisfied.

As to **requirement (6)**, petitioner has provided a statement explaining why according the application status under 37 CFR 1.47(b) is necessary to preserve the rights of the parties or to prevent irreparable damage ("Declaration By Stephen A. Terrile...", para. III. (4)); as such, requirement (6) has now been satisfied.

DECISION

The petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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